C. Remarks

In response to the Office Action dated March 18, 2004, Applicant respectfully requests favorable reconsideration of this application based on the foregoing claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

At page 2 of the Office Action claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lazardis et al (U.S. Patent No. 6,219,694) in view of McCutcheon et al (U. S. Patent No. 6,161,007). Applicant respectfully traverses the rejection based on the amendments above and the following remarks.

Applicant submit that the Office has failed to establish a *prima facie* case of obviousness with respect to claims 1 and 13 at least because the cited references, taken alone or in combination, fail to teach or suggest all of the elements of claims 1 and 13. Accordingly, Applicant submits that the rejection of claims 1 and 13 is improper.

A *prima facie* case of obviousness under 35 U.S.C. § 103(a) requires, among other things, that the cited references, when combined, teach or suggest every element of the claim. *See* MPEP §2142. Applicant submits that the Office has not established a *prima facie* case of obviousness at least because not all elements of claims 1 and 13 are taught or suggested by the cited references taken alone or in combination.

First, the invention of claim 1, as amended, provides:

> An apparatus for sending a message received from a sender to a wireless device over a wireless network, the apparatus comprising:
> a gateway for receiving the message transmitted over an external network in communication with the gateway, the message including a delivery instruction and delivery information indicating a time at which the message is to be delivered to the wireless device, for storing the message, and for carrying out the delivery instruction by delivering the message at the time indicated by the delivery information;
> wherein the delivery instruction and the delivery information is set by the sender.

Applicant respectfully submits that the Lazaridis and the McCutcheon references, taken alone or in combination, fail to teach or suggest at least that "the delivery instruction and the delivery information is set by the sender."

Consider first the Lazaridis reference. Although the Lazaridis reference discloses a method of sending a text message from a PC located on a LAN through the Internet into a gateway and onto a pager, nowhere does the reference disclose, teach or suggest that the text message includes a delivery instruction and delivery information set by the sender of the message. Rather, the Lazaridis reference merely discloses sending a message from a user's office PC (host system) to the user's mobile data communication device by way of a redirector program associated with the host system. *See* Lazardis at col. 5, lines 36-56, for example. There is no disclosure, teaching or suggestion, however, that the message contains instructions set by the sender of the message. The redirector program operates at the host and checks for trigger flags, adds an outer envelope to the message, and forwards the message to the user. *See* Lazardis at Fig. 4, for example. The basic functions of the redirector program are to:

> (1) configure and setup the user-defined event trigger points that
> will start redirection; (2) configure the types of user data items for
> redirection and optionally configure a preferred list of senders
> whose messages are to be redirected; (3) configure the type and
> capabilities of the user's mobile data communication device; (4)
> receive messages and signals from the repackaging systems and the
> event generating systems; and (5) command and control the
> redirection of the user-selected data items to the mobile data
> communication device via the repackaging systems.
>
> *See* Lazardis at col. 10, lines 40-52, for example.

The redirector program, however, does not process messages from the sender that include the message's delivery instruction and the delivery information as set by the sender.

Furthermore, as acknowledged in the Office Action, nowhere does the Lazaridis reference

disclose a message header indicating what time the message should be delivered. The Lazaridis reference fails to disclose, teach or suggest that the delivery instruction and the delivery message indicate a time at which the message is to be delivered by a gateway to a wireless device. Lazaridis merely discloses that the redirector program at the host processes the messages in accordance with its basic functions as discussed above. The gateway acts merely as a pass through and performs no processing or delayed delivery of the message based on information contained in the message as set by the sender.

The McCutcheon reference merely discloses transferring a message from a first communication device to a second communication device and then, optionally, to a third communication device (the apparatus). *See* McCutcheon at col. 2, lines 6-9, and lines 45-50. The message is processed at the second communication device and then may be transmitted to the apparatus. *See* McCutcheon at col. 2, lines 18-19. The message is subsequently converted into a format based on a user's input by the apparatus before the message is output by the apparatus (the third communication device). *See* McCutcheon at col. 2, lines 22-24. Although the McCutheon reference discloses that the message header contains information such as date of delivery of the message and time of delivery of the message to the apparatus, the reference fails to disclose, teach or suggest in any form that the message header contains delivery instructions and delivery information set by the sender. Rather, the instructions are set at the apparatus. The McCutcheon reference therefore, fails to disclose, teach or suggest at least that "the delivery instruction and the delivery information is set by the sender." Rather, as alleged in the Office Action, at col. 3, lines 65-67, the McCutcheon reference merely discloses a message header indicating what time the message was delivered to a user. The sender does not set the instruction and delivery information within the message.

Furthermore, the McCutcheon reference fails to disclose, teach or suggest at least that the message includes "a delivery instruction and delivery information indicating a time at which the message is to be delivered to the wireless device." The McCutcheon reference merely discloses

the date and time the message was delivered to the apparatus but does not disclose, teach or suggest that the message includes a date and time at which the apparatus is to deliver the message to another device, such as the "wireless device" recited in claim 1, once the apparatus receives the message. Claim 1 of the present invention recites that the gateway will deliver the message to a wireless device at a time specified in the message.

In addition, none of the first, second or third communication devices (the apparatus) disclosed in the McCutcheon reference are gateways for processing communication information. Rather, the apparatus disclosed in this reference is some form of answering machine. Moreover, the message received by the apparatus is not delivered to a wireless device at a time specified in the delivery instructions contained in the message, as recited in claim 1. In contrast, the McCutcheon reference merely discloses that it provides the user with more flexibility in determining how and when an incoming communication could and should be processed.

The alleged combination of the Lazaridis and the McCutcheon references also fails to disclose, teach or suggest a "message including a delivery instruction and delivery information indicating a time at which the message is to be delivered to the wireless device" and that the "delivery instruction and the delivery information is set by the sender," as recited in claim 1, as amended.

Applicant submits that claim 1 is not obvious over the Lazaridis reference in view of the McCutcheon reference at least because these cited references, taken alone or in combination, fail to disclose, teach or suggest each and every element recited in claim 1, as amended. Therefore, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claim 1. *See* MPEP §2142 (a *prima facie* case of obviousness under 35 U.S.C. §103(a) requires, among other things, that the cited references, when combined, teach or suggest every element of the claim). Claims 2-12 also are not obvious over the cited references at least because they depend from claim 1, either directly or indirectly. Therefore, Applicant respectfully requests withdrawal of the obviousness rejection with respect to these dependent claims. *See* MPEP §2143.03 (stating

that if an independent claim is non-obvious under §103(a), then any claim depending therefrom is non-obvious).

Second, for reasons analogous those discussed above with respect to claim 1, Applicant respectfully submits that the Lazaridis and McCutheon references, taken alone or in combination, fail to disclose, teach or suggest every element recited in amended claim 13. For example, neither reference discloses, teaches or even suggests:

> A method of sending a message by a sender to a user of a wireless device over a wireless network, the method comprising:
> sending a message including a delivery instruction and delivery information indicating a time at which the message is to be delivered to the wireless device;
> storing the message; and
> delivering the message to the wireless device over the wireless network at the time indicated by the delivery information;
> wherein the delivery instruction and the delivery information is set by the sender ...,

as recited in claim 13, as amended.

More specifically, the cited references, taken alone or in combination, fail to disclose, teach or suggest "sending a message including a delivery instruction and delivery information indicating a time at which the message is to be delivered to the wireless device" and that "the delivery instruction and the delivery information is set by the sender," as recited in claim 13, as amended.

Therefore, Applicant submits that claim 13 is not obvious over the Lazaridis reference in view of the McCutcheon reference at least because the cited references, taken alone or in combination, fail to disclose, teach or suggest each and every element recited in claim 13, as amended. Accordingly, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claim 13. *See* MPEP §2142 (a *prima facie* case of obviousness under 35 U.S.C. §103(a) requires, among other things, that the cited references, when combined, teach or suggest

every element of the claim). Claims 13-20 also are not obvious over the cited references at least because they depend from claim 13, either directly or indirectly. Accordingly, Applicant respectfully requests withdrawal of the obviousness rejection with respect to these dependent claims. *See* MPEP §2143.03 (stating that if an independent claim is non-obvious under §103(a), then any claim depending therefrom is non-obvious).
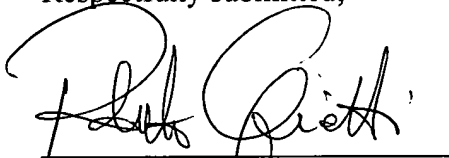
Applicant is not otherwise conceding, however, the correctness of the Office's rejection with respect to any of the dependent claims discussed above and hereby reserves the right to make additional arguments as may be necessary because the dependent claims contain additional features that further distinguish them from the cited references, taken alone or in combination. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

Claims 21-59 are newly submitted. Support for the claims may be found in the specification and drawings as filed. No new matter has been added. Applicant respectfully submits that the new claims are patentable over the cited art of record and are in condition for allowance.

D. Conclusion

As all of the issues raised in the Office Action have been addressed, the Applicant respectfully requests favorable reconsideration of this application and the issuance of a notice of allowance with respect to the pending claims. If the Examiner believes that the present application is in condition for disposition other than allowance, Applicants respectfully request that the Examiner contact the undersigned at the telephone number listed below so that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,

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